



Docket No. 8971-017-27

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: DUNCAN W. McBRANCH, ET AL. GAU: 1645
SERIAL NO: 09/934,680 EXAMINER: UNASSIGNED
FILING DATE: AUGUST 23, 2001
FOR: PEPTIDE NUCLEIC ACID BASED MOLECULAR SENSORS FOR NUCLEIC ACIDS

PETITION PURSUANT TO 37 C.F.R. §1.47(a)

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

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OFFICE OF PETITIONS

SIR:

Pursuant to the provisions of 37 C.F.R. §1.47(a), it is respectfully requested that the above-captioned application, and the Declaration in support thereof, be accepted on behalf of inventors Duncan W. McBranch and David G. Whitten, whose executed Declaration is submitted herewith, and on the behalf of the non-signing inventor, Michael Egholm. Mr. Egholm has declined to execute the Declaration being filed in the above-captioned matter. Mr. Egholm has given no statement as to his reasons for his refusal to sign.

The pertinent facts are as follows:

1. The above-referenced application was conceived of and reduced to practice by Duncan W. McBranch, David G. Whitten, and Michael Egholm.
2. At the time of conception and reduction to practice of the above-identified application, Mr. Egholm was an employee of Tropix, Inc. and Mr. McBranch and Mr. Whitten were employees of QTL Biosystems.

3. On May 17, 2000, Tropix, Inc. and QTL Biosystems signed a Mutual Confidentiality and Nondisclosure Agreement regarding the subject matter that is now disclosed and claimed in the above-identified application.

4. An application for patent entitled "Peptide Nucleic Acid Based Molecular Sensors for Nucleic Acids" on behalf of Mr. McBranch, Mr. Whitten, and Mr. Egholm was filed on August 23, 2001.

5. On October 13, 2001, Mr. Egholm sent an email to co-inventor David Whitten acknowledging the receipt of the Declaration and Assignment for the above-identified application. Mr. Egholm indicated that he was going to contact Andrew Karnakis, an attorney for Tropix, Inc, to determine if he should sign these documents. (E-mail is attached hereto as Exhibit A). No executed documents were received.

6. On or about March 13, 2002, Steven Kelber, attorney for Mr. McBranch and Mr. Whitten contacted Mr. Karnakis by telephone. Mr. Karnakis recalled the situation concerning the Declaration and Assignment for Mr. Egholm, but could not recall his instructions to Mr. Egholm regarding the same. Although Mr. Karnakis indicated that he would review the file and contact Mr. Kelber directly, his attendance at trial has apparently precluded his contacting Mr. Kelber.

7. On or about March 18, 2002, another copy of the Declaration and Assignment for the above-referenced application was forwarded to Mr. Egholm for his execution. No executed documents have been received.

8. To date, Mr. Egholm has refused to execute either the Declaration or the Assignment for the above-identified application.

9. Michael Egholm's last known address is 8 Dogwood Court, Woodbridge, Connecticut, 06525.


10. QTL Biosystems has rights and thus acceptance on behalf of Duncan McBranch and David Whitten, the real parties-in-interest is sought herein.

11. The required fee of \$130.00 specified in 37 C.F.R. §1.17(h) is submitted herewith by check and any further charges may be made against the Attorney of Record's Deposit Account No. 50-1442.

You are invited to contact undersigned counsel for further information that may be required. It is understood that the non-signing inventor may subsequently join the application on filing of an appropriate declaration.

Respectfully submitted,

PIPER MARBURY RUDNICK & WOLFE



Steven B. Kelber
Registration No: 30,073
Attorney of Record

Amy L. Miller
Registration No: 43,804

1200 Nineteenth Street, N.W.
Washington, D.C. 20036-2412
Telephone : (202) 861-3900
Facsimile: (202) 223-2085



EXHIBIT A

TO THE

PETITION PURSUANT TO 37 C.F.R. §1.47(a)

ATTORNEY DOCKET NO. 8971-017-27
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